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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,007	11/21/2001	Judith C. Clark	040094/0101	9546
22428	7590	05/12/2004	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			SPERTY, ARDEN B	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 05/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/989,007

Applicant(s)

CLARK, JUDITH C.

Examiner

Arden B. Sperty

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04/27/04 Telephone Interview.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 21-29, 34 and 43-66 is/are pending in the application.
- 4a) Of the above claim(s) 1-7, 14, 21-29, 34, 43, 47, 50-52, 56-60, 62, 63 and 65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-13, 44-46, 48, 49, 53-55, 61, 64 and 66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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NON-FINAL OFFICE ACTION

1. Applicant's Request for Continued Examination and accompanying arguments are acknowledged.
2. New claims 55-66 have been added. Claims 1-14, 21-29, 34, 43-66 are pending. Pending claims have been reevaluated for a restriction requirement due to the numerous claim amendments and the resultant diverging nature of the claims.
3. Claims 8-13, 44-46, 48, 49, 53-55, 61, 64 and 66 are currently examined.

Election/Restrictions

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-13, 28, 29, 34, 43-46, 48-50 and 53-66, drawn to attachment mechanisms/devices, classified in class 428, subclass 99.
 - II. Claims 14 and 24-27, drawn to a reusable ornament, classified in class 428, subclass 7.
 - III. Claims 21-23 and 51-52, drawn to a method of making an attachment device, classified in class 156, subclass 66.
 - IV. Claim 47, drawn to a method of using an attachment device, classified in class 156, subclass 60.

5. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation.

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Inventions I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case The attachment device can be made by a materially different method such as by first coupling the releasably attachable surfaces, then attaching to a second object, then attaching to a first object.

Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions having different modes of operation are:

Inventions I and IV;

Inventions II and III;

Inventions II and IV;

Inventions III and IV;

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. Because these inventions are distinct for the reasons given above and separate searches are required, restriction for examination purposes as indicated is proper.

8. In the event that Group I is selected, Applicant is further required to select one of the indicated species. Group I contains claims directed to the following patentably distinct species of the claimed invention:

An attachment mechanism/device comprising a backer joined to a first object by:

1. an adhesive (claims 1-4, 7, 28, 29, 34, 43, 60, 62, 63, 65);
2. an integrally formed connector (claims 5, 6, 50, 56, 57);

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3. an affixing element with first and second ends (claims 8-13, 44-46, 48, 49, 53, 54, 61, 64, 66);

4. a post or cylinder (claims 58, 59).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

9. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

10. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

11. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

12. During a telephone conversation with Phillip Articola on April 28, 2003 a provisional election was made with traverse to prosecute the invention of Group I, species 3, claims 8-13, 44-46, 48, 49, 53-55, 61, 64, 66. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-7, 14, 21-29, 34, 43, 47, 50-52, 56-60, 62-63 and 65 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

13. Claim 3 is objected to because of the following informalities: a semi-rigid element is listed twice. Appropriate correction is required.

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All claims containing "deattaching," "deattachable," etc, are objected to because "deattach-" is not a word. "Detaching" and "detachable" are words. Appropriate correction of these spelling errors is required.

Claim Rejections - 35 USC § 112

14. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

15. All pending claims are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for hook and loop fasteners and double sided adhesives, does not reasonably provide enablement for all releasably attachable surfaces. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The claims are infinitely more broad than the specification.

Claims 58, 59 and 64 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Regarding claims 58 and 59, the "cylinder" and the "post" limitations are not described in the specification. To overcome this rejection Applicant is requested to point to specific recitations in the specification of a "cylinder" and a "post." These claims have not been examined because the structural relationship of the components is unknown. Regarding claim 64, the "slot" limitation is not described in the specification.

16. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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17. All pending claims are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant's use of inconsistent terminology renders the claims indefinite. "Attachment mechanism," "attachment device," and "device" appear to be used interchangeably, and will be examined accordingly. If such is the case, amendment to the claims is required so that terminology throughout the claims **and specification** is consistent. It is further unclear if there is a difference in scope between "releasably attachable unit" and releasably attachable pad." Claim 10 requires a "coupling component," which is understood to be synonymous with "affixing element." These examples are not comprehensive. Amendment to the claims is required so that terminology throughout the claims **and specification** is consistent.

18. Claims 10, 11 and 13 are indefinite because the structure of the claimed attachment device is incomprehensible, and therefore unsearchable. These claims have not been examined. Regarding claim 10, it is unclear what is intended as a "coupling component" which can be fitted "around" a portion of the first object. Stating that it can fit around the first object does not imply any particular structure. Is there a reason why the coupling component can only fit around a portion of the first object? One of ordinary skill in the art would need to know what the object is, what portion is referred to, and the size of the portion in order to make or use the invention accordingly. There is insufficient antecedent basis for the elastic band limitation in the claim. The term "regions" is a relative term which renders the claim indefinite. Is there any structural or visual indication of where each region is located? Is it merely a matter of preference where the regions are located? There must be some sort of intended structure for the "regions" if they are able to "receive" something. What other structure can the regions have besides holes? Also, what portion of the elastic band is between the first releasably attachable pad and the one surface of the backer/stabilizer that has already "received" the ends of the elastic band? Regarding claim 11, what is the structural

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difference between a hole and an opening? It is unclear how b) is different from a). Claim 13 is rejected because it is dependent on indefinite claims.

19. Claim 46 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The interpreted structure is one in which the coupling is located between the backer and the first releasably attachable unit, while the ends are on the other side of the backer. How is this possible? The specification does not adequately explain this embodiment.

20. Claim 55 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The last two lines of the claim are redundant.

21. Claims 61 and 64 are internally inconsistent because the terms "affixing element" and "connecting element" are both used to refer to the same item. This interpretation is based on the requirement that the affixing element "corresponds to" a connecting element having a first and second end. The language is understood to mean, "the affixing element has a first and second end." The unnecessary wordiness makes the claims confusing.

Claim Rejections - 35 USC § 102

22. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

23. Claims 8, 9 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5566477 to Mathis.

Regarding, claims 8 and 9, the reference teaches a removable shoelace cover (attachment device) comprising a shoelace 24 (affixing element having first and second ends), a non-rigid plastic

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shoelace cover 28 (backer/stabilizer) including a strap 40, sections of loop hook fastener 50, 52 (first releasably attachable unit) adhered to the shoelace cover 28 (col 4, lines 49-54), sections of loop hook fastener 62, 64 (second releasably attachable unit), glue or the like (adhesive strip) (col 4, lines 49-54) attaching the loop hook fastener to the fashion panel 30 (second object), the strap 40 forming a loop with first and second openings through which the shoelace 24 passes (end of the affixing element), and wherein the ends of the shoelace are tied. Slot 34 is the integrally formed attaching/connecting means for connecting the shoelace cover 28 to the shoe.

Regarding claim 12, the channel or loop formed by the strap on the side of the shoelace cover facing the shoelace (second surface) allows for passage of the shoelace 24.

24. Claims 55, 61, 64 and 66 are rejected under 35 U.S.C. 102(b) as being anticipated by the standard definition of Velcro™ cited in a previous office action and already of record.

The attachment device of the claims as drafted comprises only a releasable attachment unit. The intended uses of the surfaces of the releasable attachment unit (for attachment to the backer/stabilizer and for attachment to the second object) hold little patentable weight. The backer/stabilizer and affixing element are not part of the attachment device as drafted. Therefore, the attachment device as drafted is anticipated by either the hook or loop portion of traditional Velcro™.

Claim Rejections - 35 USC § 103

25. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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26. Claims 8, 9, 12 and 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,709,013 to Stanback in view of USPN 5,857,469 to Sowell, supported by USPN's 3751769, 6516853, 3301266, 6047708.

Regarding claims 8, 9, and 44-46, the Stanback reference teaches an attachment device for interchangeable ornaments. The device comprises a plastic base unit 16 (col 2, lines 51-53) (backer/stabilizer) and an elastic band 44 (affixing element) fitted through openings in the base unit and coupled. Although the reference does not specifically show the coupling of the ends, such a feature is inherent since the band must have open ends in order to thread through the holes as shown. The ends of the elastic band taught by Stanback may be coupled at any point along the band. Elastic bands such as these are notoriously well-known, as supported by USPN's 3751769, 6516853, 3301266, 6047708. Regarding the location of the coupling as required by claims 44-46, absent a showing of unexpected results regarding the placement of the coupled ends, no patentable weight is given to the requirement that the ends be coupled between the backer and the first releasably attachable unit. The Stanback reference is silent with respect to first and second releasably attachable units. The Sowell reference teaches an attachment device for interchangeable ornaments comprising hook and loop fastener material or adhesive tape as the releasably attachable units. It would have been obvious to one of ordinary skill in the art to use the updated releasably attachable fasteners of Sowell in the invention of Stanback motivated by a desire to eliminate safety concerns associated with the sharp pin of the Stanback reference.

Regarding claim 12, the Stanback reference is silent with respect to channels formed on the surface of the base unit, however such channels are unnecessary because the elastic band does not interfere with the pin securement device. However, it would have been obvious to one of ordinary skill in the art to form channels for the elastic band motivated by a need for a flush mount since the combination of Stanback and Sowell as described above, requires the hook and loop material or adhesive tape to contact the base unit.

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27. Claims 48, 49, 53 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stanback in view of Sowell, and further in view of USPN 6,572,945 to Bries.

With regard to claims 48, 49, 53 and 54, the Stanback reference teaches an attachment device for interchangeable ornaments. The device comprises a plastic base unit 16 (col 2, lines 51-53) (backer/stabilizer) and an elastic band 44 (affixing element) fitted through openings in the base unit and coupled. Although the reference does not specifically show the coupling of the ends, such a feature is inherent since the band must have open ends in order to thread through the holes as shown. The ends of the elastic band taught by Stanback may be coupled at any point along the band. Elastic bands such as these are notoriously well-known, as supported by USPN's 3751769, 6516853, 3301266, 6047708. Regarding the location of the coupling as required by claims 44-46, absent a showing of unexpected results regarding the placement of the coupled ends, no patentable weight is given to the requirement that the ends be coupled between the backer and the first releasably attachable unit. The Stanback reference is silent with respect to first and second releasably attachable units. The Sowell reference teaches an attachment device for interchangeable ornaments comprising hook and loop fastener material or adhesive tape as the releasably attachable units. It would have been obvious to one of ordinary skill in the art to use the updated releasably attachable fasteners of Sowell in the invention of Stanback motivated by a desire to eliminate safety concerns associated with the sharp pin of the Stanback reference.

Further regarding claims 48 and 49, the Bries reference teaches double-sided adhesive to releasably attach hook and loop fastener materials to objects (col 8, lines 49-64) without damaging the surface of the object (col 1, lines 6-11). It would have been obvious to one of ordinary skill in the art to use the double-sided adhesive with non-adhesive tab portions in the combination of Stanback and Sowell, motivated by the desire to prevent damage to the surface of the plastic base unit.

Response to Amendment

The amendment filed March 11, 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce

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new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the "cylinder" and "post" limitations are new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

Response to Arguments

Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new grounds of rejection.

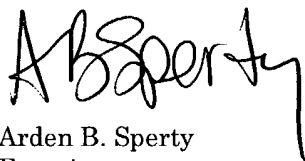
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Such prior art can be found in the attached PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arden B. Sperty whose telephone number is (571)272-1543. The examiner can normally be reached on M-Th, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571)272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arden B. Sperty
Examiner
Art Unit 1771

30 April 2004



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